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10/647,451	08/26/2003	Toshiyuki Yano	116870	3236

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EXAMINER

GETANEH, MESFIN S

ART UNIT	PAPER NUMBER
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4157

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/647,451	Applicant(s) YANO, TOSHIYUKI	
	Examiner Mesfin Getaneh	Art Unit 4157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: (Taken from PG Pub No. 2004/0109194)

There are misspellings in paragraph [0009] and [0015]. Appropriate correction is required.

2. **Claim 1** objected to because of the following informalities: (Taken from PG Pub No. 2004/0109194)

There is a misspelling in claim 1. "A image reading" has to be changed to "An image reading". Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claim 14** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 14 as recited is not patent eligible. See MPEP 2106.01 (I). Specifically, "A program making a computer conduct a process" does not fall within a statutory category of a machine, an article of manufacture, a composition of matter, or a process because it is not clear whether a "program" as recited is for causing the computer to execute it as claimed. It could very well imply manual operation of turning on a computer to

perform a process. The claim could be remedied by reciting in the preamble " a computer (software) program encoded in a computer-readable medium when executed by the computer comprising:"

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claim 1-14** are rejected under 35 U.S.C. 102(e) as being anticipated by Teraura (Pub US 20020170973).

With regards to **claim 1**, Teraura discloses A image reading system comprising (copy machine with a facsimile function in FIG. 2): an image display member on which an image is displayed (printing paper 13 of FIG. 1); and an image reading apparatus, wherein: the image display member includes a data supply device for storing a predetermined data and supplying the stored predetermined data to an external (RFID tag 14 in FIG. 3A); the image reading apparatus includes: an image reading unit for reading the displayed image (a scanner 6 of FIG. 2 reads an image on the sheet of document paper [0068] and [0069]); a data reading unit for reading the supplied predetermined data from the image display member (The reader-writer for recording

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data from the RFID data in RFID tag 14 of the printing paper [0071]); an output unit for outputting at least one of the read image and the read predetermined data (printing unit 11 and LCD unit 35 in FIG. 5); and a control unit for controlling at least one of the image reading unit and the output unit in response to whether or not the supplied predetermined data has been read (Control circuit 29 in FIG. 5).

With regards to **claim 2**, an image reading apparatus comprising (copy machine with a facsimile function in FIG. 2): an image reading unit for reading an image displayed on an image display member (a scanner 6 of FIG. 2 reads an image on the sheet of document paper [0068] and [0069]); a data reading unit for reading a predetermined data stored in the image display member (The reader-writer for recording data from the RFID data in RFID tag 14 of the printing paper [0071]); an output unit for outputting at least one of the read image and the read predetermined data (printing unit 11 and LCD unit 35 in FIG. 5); and a control unit controls at least one of the image reading unit and the output unit in response to whether or not the supplied predetermined data has been read (Control circuit 29 in FIG. 5).

With regards to **claim 3**, The image reading apparatus according to claim 2 (the same apparatus as claim 2), wherein: when the predetermined data has been read, the control unit controls the output unit to output at least one of the read image and the read predetermined data in response to the read predetermined data; and when the predetermined data has not been read, the control unit controls the output unit to output the read image (FIG. 6 and FIG. 7).

With regards to **claim 4**, The image reading apparatus according to claim 3 (the apparatus as claim 3), wherein: the control unit judges an attribute of the read predetermined data on the basis of attribute data contained in the read predetermined data; and the control unit controls at least one of the image reading unit and the output unit in response to whether or not the judged attribute is an attribute indicating data, which is printable as an image ([0081], [0082], and [0083]).

With regards to **claim 5**, The image reading apparatus according to claim 4 (the same apparatus as claim 4), further comprising: an operation unit for promoting a user to select at least one of the read image and the read predetermined data as output data to be output, when the judged attribute is the attribute indicating the printable data as an image, wherein: when the judged attribute is the attribute, which is printable as an image, the control unit controls the image reading unit to stop reading the displayed image (In FIG. 7, the control circuit 29 and the LCD 35 perform these tasks as described in [0087] – [0089]).

With regards to **claim 6**, The image reading apparatus according to claim 5 (the same apparatus as claim 5), wherein: the operation unit receives an operation for selecting the output data; and when the output data is selected, the control unit controls the image reading unit to restart reading the displayed image and controls the output unit to output the selected output data (Control circuit 29 in FIG. 5).

With regards to **claim 7**, The image reading apparatus according to claim 6 (the same apparatus as claim 6), wherein: the operation unit further receives another operation for designating an output format at a time of outputting the output data; and

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the control unit controls the output unit to output the selected output data in the designated output format (the control circuit 29 and the LCD 35 in FIG. 5).

With regards to **claim 8**, The image reading apparatus according to claim 7 (the same apparatus as claim 7), wherein: when the read image and the read predetermined data are selected as the output data, the control unit controls the output unit to print the read image and the read data on different image formation media in accordance with the designated output format, respectively (the control circuit 29 and the printing unit 11 [0093]).

With regards to **claim 9**, The image reading apparatus according to claim 7 the same apparatus as claim 7), wherein: when the read image and the read predetermined data are selected as the output data, the control unit controls the output unit to print the read image and the read predetermined data on both surfaces of an image formation medium in accordance with the designated output format, respectively (the control circuit 29 and the printing unit of FIG. 5 are inherently capable of performing these operations).

With regards to **claim 10**, The image reading apparatus according to claim 7 (the same apparatus as claim 7), further comprising: a synthesizing unit for synthesizing the read image with the read predetermined data in accordance with the designated output format, wherein: when the read image and the read predetermined data are selected as the output data, the control unit controls the output unit to output the synthesized data in accordance with the designated output format (see the flow chart in FIG 8, steps B21, B23, and B24 and paragraph [0094] and [0095]).

With regards to **claim 11**, The image reading apparatus according to claim 10 (the same apparatus as claim 10), wherein: the synthesizing unit synthesizes the read image with the read predetermined data in accordance with the designated output format so that the read image and an image indicated by the read predetermined image are displayed in a superimposed manner (the control circuit 29 and the LCD unit 35 of FIG. 5 is inherently capable of performing these operations).

With regards to **claim 12**, The image reading apparatus according to claim 10 (the same apparatus as claim 10), wherein: the synthesizing unit synthesizes the read image with the read predetermined data in accordance with the designated output format so that the read image and an image indicated by the read predetermined image are displayed side by side (the control circuit 29 and the LCD unit 35 of FIG. 5 is inherently capable of performing these operations).

With regards to **claim 13**, An image reading method (the apparatus as claimed in claim 1 inherently imply the method as claimed) comprising: reading a predetermined data stored in an image display member (data reading unit of claim 1); controlling at least one of a process for reading an image displayed on the image display member and a process for outputting the read image in response to whether or not the supplied predetermined data has been read (control unit of claim 1); performing the process for reading the image displayed on the image display member in accordance with the control (image reading unit of claim 1); and outputting at least one of the read image and the read predetermined data in accordance with the control (output unit of claim 1).

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With regards to **claim 14**, A program making a computer conduct a process comprising: reading a predetermined data stored in an image display member; controlling at least one of a process for reading an image displayed on the image display member and a process for outputting the read image in response to whether or not the supplied predetermined data has been read; performing the process for reading the image displayed on the image display member in accordance with the control; and outputting at least one of the read image and the read predetermined data in accordance with the control (claim 14 is a computer program performing the operation the steps of claim 13 using the apparatus of claim 1. Using a computer program to perform these kinds of tasks is well known in the art. The PC 39 in FIG. 5 can be programmed to perform these tasks).

Conclusion

7. The prior art made of record and not relied upon is considered to applicant's disclosure.

Minami et al. (US Patent 7,048,194) teaches a printing paper that set in the printer and used for printing and a printer apparatus. The printing paper has memory element that stores printing information used for printing such as paper size, paper direction, and paper type. It also teaches a printing apparatus that detects whether there is a memory element is attached to the printing paper.

Contact

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mesfin Getaneh whose telephone number is (571) 270-3752. The examiner can normally be reached on 8:00AM-5:00PM est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mesfin Getaneh
Patent Examiner


SUPERVISORY ~~PATENT EXAMINER~~